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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,441	08/20/2003	Donald W. Dine	G00352/IUS	7039

35758 7590 03/30/2005

GKN DRIVELINE NORTH AMERICA, INC  
3300 UNIVERSITY DRIVE  
AUBURN HILLS, MI 48326

EXAMINER
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BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/644,441

Applicant(s)

DINE ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7 and 9-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-14 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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*Election/Restrictions*

1. Claims 15-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on October 7, 2004.

*Terminal Disclaimer*

2. The terminal disclaimer filed on Feb 22, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on U.S. Application No. 10/644,442 has been reviewed and is accepted. The terminal disclaimer has been recorded.

*Claim Objections*

3. Claims 9-11 are objected to because:
- a. Claim 9, last: "the tubular member" should be changed to "the metal tube"
  - b. Claim 10: the word "first" is misspelled
  - c. Claim 11: the word "openings" is misspelled

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1, 2, 4-7, 9-14 & 20-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 9 & 14 each recites the limitation, "a tubular support member having a generally uniform outer diameter". Applicant has not pointed out where this limitation is supported, nor does there appear to be a written description of the limitation in the application as originally filed..

6. Claims 4, 6, 7 & 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 4 recites the limitation "assembly according to claim 3". There is insufficient antecedent basis for this limitation in the claim.

b. Claims 6, 7 & 20-22 recite the limitation "said tubular member". However, it is not clear which of the previously recited tubular members is "said tubular member".

*Claim Rejections - 35 USC § 102*

7. Claims 1, 6, 7, 9, 10, 14, 22 & 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill, US 6,254,488. Figs. 1 & 2 show a propeller shaft assembly 10 comprising: a metal tubular member 14; a joint element 32, 34 fixed to each end 16 of the tubular member; and a tubular support member 30 having a generally uniform outer diameter over most of its length

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fixed with the tubular member. In col. 2, line 16, the support member is disclosed as being made from foamed plastic. The figures show the tubular member has a length that is greater than that of the support member.

8. Claims 1, 4, 6, 7, 9-11, 14, 22 & 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Schuermann et al, EP 0 471 240 (Schuermann). The figure shows a propeller shaft assembly comprising a reinforced plastic (see "FRP" in the English language description provided by DERWENT) tubular member 1, a joint element 2 fixed to each end of the tubular member, and a tubular support member 6, having a generally uniform outer diameter over most of its length and with a plurality of openings 9, fixed within the tubular member. In the English language description provided by DERWENT the support member is disclosed as being made from foamed plastic. The figure shows the tubular member 1 has a length that is greater than that of the support member 6.

*Claim Rejections - 35 USC § 103*

9. Claims 2, 5, 12, 13, 20 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuermann.

a. Claims 2, 5, 12 & 13. In the English language description provided by DERWENT, Schuermann discloses that the support member is made from foamed plastic, but does not disclose the foam being impregnated with a high modulus resin. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to impregnate the foam of the support member with a high modulus resin in order to provide a means

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for sound absorption because such a modification is well known in the art. (See Fletmier et al, US 6,156,682 (Fletmier) in col. 1, lines 14-26 where it is disclosed that it is well known in the art to impregnate foam with a high modulus resin in order to provide a means for sound absorption.)

b. Claims 20 & 21. Schuermann shows an assembly comprising all the limitations of the claims but does not expressly disclose making the tubular member with a thickness generally less than 8 mm and an outer diameter between 40 and 300 mm. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the tubular member with a thickness generally less than 8 mm and an outer diameter between 40 and 300 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056.

10. Claims 2, 5, 12, 13, 20 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill for the same reasons noted above.

#### *Response to Arguments*

11. Applicant's arguments filed Feb 22, 2005 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the support member having a uniform outer diameter over its entire length) are not recited in the rejected

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claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda  
Primary Examiner  
Art Unit 3679